

### **REMARKS**

Claims 1 and 17 are amended herein. Support for the amendments to Claims 1 and 17 is found in the specification, for example in the Abstract. Accordingly, no new matter is added by the amendments.

New Claim 19 is added herein. New Claim 19 is supported by the specification, for example, at paragraph [0054]. Accordingly, no new matter is added by the new claim.

Upon entry of the amendment, Claims 1, 2, 6-8, 10, 11 and 16-19 are under examination.

### **Rejection of Claims 1, 2, 6-8, 10, 11, 16 and 17 under 35 U.S.C. § 103**

Claims 1, 2, 6-8, 10, 11, 16 and 17 are rejected under 35 U.S.C. § 103 as being obvious over Miyakawa (US 4,557,856).

Applicants respectfully submit that Miyakawa does not teach all of elements of the present claims, and that it would not have been obvious to modify teachings of Miyakawa to arrive at the claimed compositions. Specifically, Miyakawa does not teach a dielectric inorganic powder-containing resin composition comprising the recited phosphorus compound.

Miyakawa teaches that Miyakawa's invention is directed to an electrically conductive composition, and a key component of the invention is an acid addition salt of an organic base. Miyakawa does not teach the presently claimed composition because (1) Miyakawa teaches an electrically conductive composition, not a dielectric inorganic powder-containing resin composition as Applicants presently claim, and (2) Miyakawa teaches that the protonically conductive compound of Miyakawa's invention is an acid addition salt of an organic base, and Miyakawa does not teach ortho-phosphoric acid itself, such as is recited in Applicants' claims, as a possible protonically conductive compound.

Miyakawa teaches an electrically conductive composition comprising a protonically conductive compound, a finely divided inorganic solid acid and a binder. Miyakawa teaches that this composition has highly improved electric conductivity and is valuable for production of an electro-sensitive recording material. *Miyakawa* at Abstract. Thus, Miyakawa's invention is drawn to an electrically conductive composition. As such, Miyakawa does not teach a dielectric inorganic powder-containing resin composition as recited in Applicants' claims.

Furthermore, Miyakawa teaches that the protonically conductive compound is the electrically conductive agent of the composition. Miyakawa teaches that the protonically conductive compound of Miyakawa's invention is an acid addition salt of an organic base. *Miyakawa* at column 3, lines 60-65. Although, Miyakawa teaches that the acid portion of the acid addition salt can contain inorganic acids such as ortho-phosphoric acid, Miyakawa does not teach use of ortho-phosphoric acid itself. *Miyakawa* at column 5, lines 17-35. Thus, Miyakawa merely teaches that ortho-phosphoric acid is one of the optional acids that can be used as the acid component of the acid addition salt of the organic base. Miyakawa does not teach that ortho-phosphoric acid alone (absent the organic base component of the salt) can be a protonically conductive compound. In fact, since all of Miyakawa's protonically conductive compounds are salts, one of ordinary skill would not consider ortho-phosphoric acid itself to be a suitable protonically conductive compound according to Miyakawa's teachings. As such, Miyakawa does not teach a composition containing a phosphorus compound such as that recited in Applicants' claims.

Moreover, any modification of Miyakawa's teachings to arrive at Applicants' claimed composition would be contrary to the teachings of Miyakawa. Since Miyakawa's invention is directed to a highly improved electric conductor that is valuable for production of electro-sensitive recording materials, Miyakawa teaches away from dielectric materials that would not possess such highly improved electric conductive properties. Thus, Miyakawa teaches away from a dielectric inorganic powder-containing resin composition such as that of Applicants' claims.

In addition, since Miyakawa teaches that the protonically conductive compound of Miyakawa's invention is an acid addition salt of an organic base, Miyakawa teaches away from using the acid form itself as a protonically conductive compound. Thus, Miyakawa teaches away from using the phosphorus compound recited in Applicants' claims.

Applicants have found that the recited compositions, when sintered, provide dielectric layers with superior transparency and surface smoothness. *See Specification* at paragraphs [0012] and [0098] and Table 1. Miyakawa is silent regarding sintering or formation of a dielectric layer. Instead, Miyakawa is directed only to the formation of electrically conductive

layers. Accordingly, the superior properties resultant from the claimed composition are unexpected and non-obvious over the teachings of Miyakawa.

**Claim 2 is Further Non-obvious over Miyakawa**

Claim 2 is further non-obvious over Miyakawa. Claim 2 is directed to the composition of Claim 1, wherein the weight-average molecular weight of the binder resin is 50,000 to 500,000. Applicants have found that the molecular weight range selected can have particular advantages when placing the composition on a transfer sheet. *See, e.g., Specification* at paragraph [0027]. The molecular weight recited in Claim 2 would not be obviously optimized based on Miyakawa's teachings because Miyakawa does not teach molecular weight as a result effective variable. In order to be a variable for which optimization would have been obvious, the variable must have been recognized in the art as result effective. *M.P.E.P. §2155.05.II.B*. Miyakawa is silent regarding the molecular weight of the binder resin. As such, Miyakawa does not teach that molecular weight is a result-effective variable. Although the Office Action indicates that this variable is result effective, there does not appear to be evidence on the record to support this contention. Accordingly, Applicants respectfully request evidence be placed on the record to support the contention that molecular weight is a result-effective variable in the context of Miyakawa's teachings. *See M.P.E.P. §2144.03* and *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). In the absence of such evidence, Applicants submit that Claim 2 is non-obvious over Miyakawa.

**Rejection of Claim 18 under 35 U.S.C. § 103**

Claim 18 is rejected as being obvious over Miyakawa in view of Fukuda (US Pat No 5,827,792).

Claim 18 depends from Claim 17. Claim 17 is non-obvious over Miyakawa in view of Fukuda because application of Fukuda's teachings to Miyakawa would render Miyakawa unsuitable for its intended purposes. As discussed above, Miyakawa is directed to electrically conductive compositions. Fukuda is directed to dielectric compositions. *Fukuda* at Abstract. Fukuda teaches selecting an inorganic powder having low softening point for the purpose of improving firing at low temperature. *Fukuda* at column 3, lines 8-32. Miyakawa teaches nothing regarding firing, and Miyakawa's working examples do not contain a firing step. More

**Application No.:** 10/565,565  
**Filing Date:** January 23, 2006

importantly, if one were to treat Miyakawa's composition by firing, it would likely damage at least one property of Miyakawa's composition (*e.g.*, the conducting property), rendering the composition unsuitable for its intended purpose. If the teachings of Miyakawa are combined with the teachings of Fukuda such that the composition is not to be fired, the advantage for selecting an inorganic powder according to Fukuda's teachings is defeated because the softening point of the inorganic compound is selected the purpose of improving firing at low temperature. Accordingly, the teachings of Miyakawa and Fukuda cannot be combined to render the composition of Claim 17 obvious. As such, the teachings of Miyakawa and Fukuda also cannot be combined to render the composition of Claim 18 obvious.

#### No Disclaimers or Disavowals

Although the present communication may include alterations to the claims, and/or characterizations of claim scope or referenced art, the Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

**Application No.:** 10/565,565  
**Filing Date:** January 23, 2006

### **CONCLUSION**

In view of the above, Applicants respectfully maintain that claims are patentable and request that they be passed to issue. Applicants invite the Examiner to call the undersigned if any remaining issues might be resolved by telephone.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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